EXPRESS MAIL NO. EL615212317US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Thomas M. BRENNAN

Application Serial No.:09/715,426

Filing Date: November 16, 2000

For: **METHOD AND APPARATUS FOR CONDUCTING AN ARRAY OF CHEMICAL REACTIONS ON A SUPPORT SURFACE**

Group Art Unit: 1637

Examiner: Fredman, J. D.

Attorney's Docket No. 05871.0002.CNUS05

Confirmation No.: 7723

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action mailed on **November 27, 2002**. Applicants hereby submit the following Response. A petition for Extension of Time for three (3) months is included herewith, which extends the due date from **February 27, 2003** to **May 27, 2003**. The three-month extension fee of $465.00 for a small entity is included herewith. It is believed that no additional fees are required. However, if any fees are required in order to maintain the pendency of the instant Application, the Examiner is expressly authorized to charge such to our Deposit Account No. 08-3038.

RESPONSE

Priority

Applicants enclose a copy of priority application, U.S. Serial No. 07/754,614 in Exhibit A for Examiner's convenience. Support for current claims can be found throughout the '614 application, for example, from page 12, line 25 to page 13, line 9. Applicants respectfully request the withdrawal of Fodor et al. as a 102(b) reference.

Rejections under 35 U.S.C. 102

Claims 18-21 and 23-26 are rejected under 35 U.S.C. 102(a) as being anticipated by Fodor et al. (*Science* 251:767-773 (1991)). Applicants respectfully traverse this rejection.

The Examiner's attention is directed to MPEP 2163.07, which states that "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the things described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" (citing *In re Robertson* 169 F.3d 743, 745 (Fed. Cir. 1999)).

The Examiner states that "a solution at a functionalized site [in Fodor et al.] is inherently separated from solutions at other functionalized sites by surface tension." The Examiner however has not met the MPEP requirement for establishing inherency. First, the Examiner cites no extrinsic evidence that makes clear the missing surface tension characteristics are necessarily present in Fodor et al. Second, persons of ordinary skill would not recognize that Fodor et al. necessarily uses surface tension to separate solutions at functionalized sites. In fact, the entire Fodor reference describes a photolithographic method, which employs various masks for photoactivation (see page 767). In other words, persons of ordinary skill in the art would not recognize that using surface tension to separate solutions at functionalized sites is necessarily present in Fodor's solid support fabricated by photolithography. Because the Examiner did not establish inherency as required in MPEP, applicants respectfully request the withdrawal of the 102(a) rejection based on Fodor et al.

Claims 18-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Pirrung et al (U.S. Patent 5,143,854). Applicants respectfully traverse this rejection.

As in Fodor et al., the Examiner relies on inherency argument to support the 102(e) rejection. Similar to applicants' arguments above, the Examiner did not establish inherency as required in MPEP because (1) no extrinsic evidence is shown to make clear

that the missing surface tension characteristics are necessarily present in the Pirrung patent; and (2) persons of ordinary skill in the art would not recognize that using surface tension to separate solutions at functionalized sites is necessarily present in Pirrung's solid support fabricated by photolithography (The Pirrung patent employs the same photolithography method in Fodor et al.). Applicants respectfully request the withdrawal of the 102(e) rejection based on the Pirrung patent.

Double Patenting

Claims 18-27 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 5,985,551. Applicants are prepared to submit a Terminal Disclaimer when claims in the instant application are in condition for allowance.

CONCLUSION

In view of the foregoing, applicants believe that the claims in the instant Application are in condition for allowance and advancement as such is earnestly requested. If, in the opinion of the Examiner, a telephonic interview would expedite the prosecution of the subject Application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: **May 16, 2003**

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